

REMARKS**Status of Claims**

The Office Action mailed November 30, 2004, has been reviewed and the Examiner's comments have been carefully considered. Claims 1-27 were pending in the application, with claims 4, 13-16 and 19-22 withdrawn from consideration. Claim 1 has been amended, claim 28 has been added and no claims have been cancelled. Therefore, claims 1-28 are pending with claims 1-3, 5-12, 17, 18, and 23-28 being submitted for reconsideration.

This amendment changes claims in this application. A detailed listing of all claims that are, or were, in the application, irrespective of whether the claim(s) remain under examination in the application, are presented, with an appropriate defined status identifier.

Amendment of the Specification

The specification has been amended to better describe the cutouts 26 as shown in the originally filed figures 8-13 and to improve its readability. This description is also consistent with the text of the priority Japanese application from which this application was translated. No new matter has been added.

Prior Art Rejections

Claims 1-3, 5-8, 17, 18, and 23-27 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 3,597,030 to Hallerback (hereafter "Hallerback") in view of U.S. Patent No. 3,854,734 to West (hereafter "West"). Claims 9-12 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Hallerback in view of West as applied to claims 1-3, 5-8, 17, 18, and 23-27 above, and further in view of U.S. Patent 4,339,565 to Tomoda (hereafter "Tomoda"). Applicants respectfully traverse these rejections for at least the following reasons.

Independent claim 1 recites, *inter alia*, that the claimed rolling bearing unit includes a number "n" of cutouts such that "n" is not equal to "Z" and "n" is not equal " $Z \pm 1$ ". This recited feature is not disclosed or suggested by the applied prior art. In fact, the office action implicitly acknowledged that the Hallerbeck did not show this claimed relationship by interpreting the claimed "or" in a manner that rendered it meaningless. As acknowledged by

the Federal Circuit, the word “or” can have a conjunctive meaning in certain situations as was the case in the pending claim 1. See *Florsheim Shoe Company v. United States*, 744 F.2d 787, 794-95 (Fed. Cir. 1984) (the Federal Circuit noted that although the term “or” may often call for a disjunctive interpretation, it need not always be so interpreted).

Furthermore, with respect to this feature, the office action notes that “Furthermore, as Hallerbeck ‘030 has not disclosed a specific relationship between the cuts and the rolling elements, it is deemed non-essentially and therefor all possible relationships between the cuts and the rolling elements are taught by Hallerbeck ‘030.” See page 4 of the Office Action.

Of course this statement turns the process of examination on its head. The Patent Office (PTO) has the burden of proving each of the claimed features is shown by the prior art. An allegation that claimed subject matter is “obvious” (as here alleged) requires a positive, concrete teaching in the prior art, such as would lead a person skilled in the art to choose the claimed combination from among many that might be comprehended by broad prior art teachings. The PTO’s review court has made it very clear that silence in a reference is hardly a substitute for clear and concrete evidence from which a conclusion of obviousness might justifiably flow. See, e.g., *Application of Burt*, 356 F.2d 115, 121 (CCPA 1966).

If, on the other hand, the PTO intended to indicate that this feature was somehow inherent in the cited reference, it should be noted that the standard for inherency requires that the feature be *necessarily present* in the prior art and not simply that it may occur or be present, i.e., be broadly included in a general or non-specific prior art teaching. See MPEP 2112 and the cases cited therein including *In Re Rijckaert*, 9 F.3d 1531, 1534 (Fed. Cir. 1993) (reversed rejection because inherency was based on what would result due to optimization of conditions, not what was necessarily present in the prior art); *In re Oelrich*, 666 F.2d 578, 581-82 (CCPA 1981) (to establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill). Accordingly, applicants submit that at least this recited feature is not disclosed by the applied prior art.

As described in the specification at page 14, lines 4-8, this claimed feature provides the advantage that it prevents non-repetitive runout from occurring during operation of the rolling bearing with shield plate even though the installation of the shield plate causes minute

deformations on the outer ring. Therefore, since neither the claimed features nor their advantages are disclosed or suggested by the applied prior art, independent claim 1 is patentable over the applied prior art.

The dependent claims are also in condition for allowance for at least the same reasons, as discussed above, as the independent claims on which they ultimately depend. In addition, they recite additional patentable features when considered as a whole. For example, new claim 28 recites a feature that is not disclosed by the prior art, and this feature provides an additional, independent reason for the patentability of this claim.

Conclusion

In view of the foregoing amendments and remarks, applicant submits that the application is now in condition for allowance. If there are any questions regarding the application, or if an examiner's amendment would facilitate the allowance of one or more of the claims, the examiner is courteously invited to contact the undersigned attorney at the local telephone number below.

Should additional fees be necessary in connection with the filing of this paper, or if a petition for extension of time is required for timely acceptance of same, the Commissioner is hereby authorized to charge deposit account No. 19-0741 for any such fees; and applicant hereby petitions for any needed extension of time.

Respectfully submitted,

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